Supreme Court, U.S.
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No. 99-

IN THE
# SUPREME COURT OF THE UNITED STATES

LRC ELECTRONICS, INC.
Petitioner,

v.

JOHN MEZZALINGUA ASSOCIATES, INC.
Respondent.

**ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

## PETITION FOR WRIT OF CERTIORARI

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25 pp

## QUESTION PRESENTED

Whether the Court of Appeals for the Federal Circuit violated petitioner's right under the Seventh Amendment to a trial by jury in a patent case by reversing a jury verdict on grounds that were expressly rejected by the jury and not appealed by respondent.

## LIST OF PARTIES

The parties before this Court are petitioner LRC Electronics, Inc. and respondent John Mezzalingua Associates, Inc. The parent company of petitioner is Thomas & Betts Corporation.

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No. 99-

IN THE
# SUPREME COURT OF THE UNITED STATES

LRC ELECTRONICS, INC.
Petitioner,

v.

JOHN MEZZALINGUA ASSOCIATES, INC.
Respondent.

## ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner, LRC Electronics, Inc., prays that a writ of certiorari be granted to review the May 27, 1999 decision of the United States Court of Appeals for the Federal Circuit, adhered to by the August 30, 1999 denial of a timely combined petition for rehearing and suggestion for rehearing *in banc*.

## I. OPINIONS BELOW

After a three-week trial, the jury returned a verdict that respondent's coaxial cable connector designated "CMP2" infringes petitioner's U.S. Patent No. 4,902,246 and that the infringement was willful. A copy of the jury verdict appears at Appendix D to this brief. In a decision dated May 27, 1999, the Court of Appeals for the Federal Circuit reversed. This decision appears at Appendix A to this brief.

## II. STATEMENT OF JURISDICTION

The Judgment of the Federal Circuit is dated May 27, 1999 and appears at Appendix B to this brief.

The Federal Circuit denied and declined petitioner's Combined Petition for Rehearing and Suggestion for Rehearing *In Banc* on August 30, 1999. This disposition appears at Appendix C to this brief.

This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

## III. CONSTITUTIONAL PROVISION INVOLVED

The Seventh Amendment to the United States Constitution provides that:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

## VI. STATEMENT OF THE CASE

This is a case for patent infringement brought by petitioner against respondent in the United States District Court for the Northern District of New York. In February, 1998, the jury determined that the CMP2 infringed petitioner's patent. The jury rejected respondent's argument that the patent claim is invalid if construed to cover the CMP2 under the doctrine of equivalents. Respondent did not appeal the jury's finding that the claim is not invalid. In a decision dated May 27, 1999, the Court of Appeals for the Federal Circuit reversed the jury's infringement finding on the basis that the patent claim, if construed to cover the CMP2, would be invalid. This

determination directly conflicts with the unappealed jury finding.

On June 10, 1999, petitioner filed a Request for Rehearing and Suggestion for Rehearing *In Banc*. Petitioner argued that the basis for the Federal Circuit's reversal had been decided by the jury in petitioner's favor and that respondent had not appealed that finding. Accordingly, petitioner argued that the Federal Circuit could not reverse on such grounds because to do so would deprive petitioner of its right to trial by jury. *See* Appendix E. The Federal Circuit denied and declined petitioner's combined petition, without opinion, on August 30, 1999.

Based on a jury finding made adversely to respondent and not appealed by respondent, the Federal Circuit reversed the jury finding of patent infringement. The Federal Circuit thereby deprived petitioner of its right to trial by jury. In particular, respondent expressly argued to the jury that the claim would be invalid if it were construed to cover the CMP2 connector which had a press-fit compression sleeve:

> But if you define compression sleeve to include press fit with no ridge, no ridge going into a groove, then this claim is invalid because press fits were around already.
>
> That's the position as far as invalidity is concerned. You can't have it both ways. This claim, we submit, his Honor will instruct you, will be interpreted the same. There is no special rule for interpreting the claim differently for validity, I believe, than there is for infringement or you won't hear any such rule. So however you define this claim for infringement, that's how you use it in terms of his definition for validity.

> And if the CMP2 infringes, then we submit it's – the claim is invalid.
>
> (Appendix F)

The jury rejected that argument and found that the claim is not invalid if construed to cover the CMP2. *See* Appendix D. Respondent did not appeal the jury's determination that the claim is not invalid. Nonetheless, on appeal, the Federal Circuit determined that the claim would be invalid if construed to cover the CMP2. Appendix A, pp. 8a-9a.

## VI. REASONS FOR GRANTING THE WRIT

The jury determined that the patent claim would not be invalid if construed to cover the CMP2 product under the doctrine of equivalents. Respondent did not appeal that finding. The Federal Circuit nevertheless reversed the jury's infringement finding on the basis that the claim would be invalid if construed to cover the CMP2 connector. The Seventh Amendment to the Constitution of the United States applies equally to all litigants including patentees. Where, as here, the jury decided the issue at hand and no appeal was taken, the Federal Circuit cannot reverse on the identical grounds. The issue of whether claim 1 of petitioner's patent is valid if construed to cover the CMP2 product was expressly determined by the jury and not appealed by respondent. Accordingly, the Federal Circuit must abide by that jury finding. To hold otherwise, renders petitioner's Seventh Amendment rights meaningless.

## THE FEDERAL CIRCUIT DEPRIVED PETITIONER OF ITS SEVENTH AMENDMENT RIGHT TO A JURY TRIAL

At trial, petitioner presented evidence that the CMP2 connector infringes claim 1 of petitioner's patent under the doctrine of equivalents. The issues of infringement and validity were both given to the jury. As indicated by the quoted passage set forth above from respondent's closing argument to the jury, respondent expressly argued to the jury that the claim would be invalid for obviousness if construed to cover the CMP2 connector. The jury rejected respondent's argument. In response to special infringement interrogatory 4 and invalidity/obviousness interrogatory number 1, respectively, the jury determined that the CMP2 infringes claim 1 of petitioner's patent under the doctrine of equivalents and that the claim is *not* invalid. *See* Appendix D. Accordingly, the jury found that the claim is not invalid when construed to cover the CMP2 product.

Respondent did not appeal the jury's determination that claim 1 is not invalid if construed to cover the CMP2 connector. Nonetheless, the Federal Circuit determined on appeal that claim 1 would be invalid if construed to cover the CMP2 connector and reversed the jury finding of infringement. *See* Appendix A, pp. 8a-9a. As respondent did not appeal the jury's determination that the claim would not be obvious if construed to cover the CMP2, the Federal Circuit cannot revive that issue on appeal. Petitioner is entitled to the benefit of the unappealed jury determination that the claim is valid when construed to cover the CMP2. The Federal Circuit's reversal on the express basis that was not appealed by respondent deprived petitioner of its right to trial by jury as guaranteed by the Seventh Amendment. Petitioner, therefore, requests this Court to issue a writ of certiorari to the Federal Circuit to correct this

error and preserve petitioner's right to trial by jury as guaranteed by the Seventh Amendment.

Respectfully submitted,

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# APPENDICES

**APPENDIX A**

**UNITED STATES COURT OF APPEALS**
**FOR THE FEDERAL CIRCUIT**

98-1545

LRC ELECTRONICS, INC.,

Plaintiff-Appellee,

v.

JOHN MEZZALINGUA ASSOCIATES, INC.,

Defendant-Appellant.

---

Decided: May 27, 1999

---

Before MICHEL, RADER, and GAJARSA, Circuit Judges.

MICHEL, Circuit Judge.

John Mezzalingua Associates, Inc., ("JMA") appeals from the order of the United States District Court for the Northern District of New York, denying JMA's motions for judgment as a matter of law ("JMOL") and for a new trial, and granting a motion for attorney fees filed by LRC Electronics, Inc. ("LRC"). See LRC Elecs., Inc. v. John Mezzalingua Assocs., Inc., No. 95-CV-1661 (FJS) (N.D.N.Y) July 10, 1998). On November 22, 1995, LRC filed a complaint against JMA, alleging infringement of LRC's U.S. Patent No. 4,902,246 ("the '246 patent"). After a ten-day trial, the jury found that JMA has

willfully infringed the '246 patent and awarded LRC a $296,734,80 lost profits damage award. After judgment was entered on the jury verdict, JMA filed post-trial motions and LRC moved for enhanced damages and attorney fees based on the verdict of willful infringement. The district court denied JMA's motions and denied LRC's motion for enhanced damages, but granted LRC's motion for attorney fees. The calculation of those attorney fees is still pending in the district court. JMA appeals the denial of its JMOL motions, its motion for a new trial, and the attorney fees award. Because the accused device was within the prior art, a finding of infringement under the doctrine of equivalents, the only infringement challenged on appeal was precluded. Therefore, we reverse the district court's denial of JMA's motion for JMOL of no infringement under the doctrine of equivalents by a later model of the originally accused device, vacate the district court's decision to deny JMOL of no willfulness and no attorney fees to LRC, and remand the case for further proceedings consistent with this opinion.

## BACKGROUND

JMA and LRC are competitors in the manufacture and sale of coaxial cable connectors. F-series coaxial cable connectors are a common class of connectors which provide an electrical connection between a coaxial cable and various electronic devices such as televisions, VCRs and radios. These connectors are also commonly used outside homes to connect a trunk or feeder line on a telephone pole to lines running to individual homes nearby. When the connectors are used outdoors, moisture can infiltrate the connection which can break down aluminum shielding within the cable and interfere with the signal the cable transmits.

In October 1988, LRC filed a patent application disclosing a connector that was designed to address the moisture problem. The trade name of the commercial embodiment of the device of that application is the "SNAP-N-SEAL" ("SNS") connector. The application ultimately issued as U.S. Patent No. 4,834,675. LRC filed a continuation-in-part application which issued as the '246 patent on February 20, 1990 (the only patent in suit). The device of this patent as commercially produced was also called an SNS connector.

In 1995, JMA introduced a connector that competed with the SNS connector of the '246 patent, which it called the CMP connector ("CMP1"). In Spring 1996, several months after LRC filed its infringement suit against JMA, JMA redesigned its CMP1 connector. Even after the redesigned CMP connector ("CMP2") replaced the CMP1, LRC still alleged that JMA was infringing the '246 patent.

Claim 1 of the '246 patent, the only claim at issue here, reads in pertinent part:

1. A snap-n-seal coaxial connector for mechanically and electrically interconnecting a coaxial cable to an electronic device...
comprising:
...
compression sleeve means for snap engaging into said connector body means to mechanically connect the coaxial cable to said connector body means, said compression sleeve means in combination with said connector body means forming a 360 degree uniform compressive moisture-proof seal

> between said compression sleeve means and the jacket of the coaxial cable...

'246 pat., col. 8, l.59 to col. 9, l. 16 (emphasis added). JMA argued that the CMP1 and CMP2 connectors do not meet the limitation emphasized above because, rather than having structure that snap engages, they have structure that press fits the compression sleeve to the connector body.

The district court's construction of claim 1, read to the jury as part of their instructions, reads in pertinent part:

> [A] compression sleeve means for snap engaging into the connector body means so as to perform that function; in this claim, compression sleeve means is what is involved or included in performing the function of compressing the compression sleeve into the connector body in a manner that snap engages them, forcing a 360-degree uniform moisture-proof seal and also preventing inadvertent disengagement.

The district court's instruction did not identify any structure in written description that corresponded to the "compression sleeve means." As to infringement, the district court instructed the jury to "consider whether the [CMP1 or CMP2 connector] used the same means as described in the specification or an equivalent means to accomplish the stated functions as set forth in claim 1."

The jury returned a verdict including the following: (1) CMP1 literally infringed the '246 patent; (2) CMP1 did not literally infringe, but did infringe under the doctrine of

equivalents; (3) JMA's infringement was willful; (4) the '246 patent was not proven invalid; (5) LRC did not commit inequitable conduct in obtaining the '246 patent; and (6) the amount of profits LRC lost due to the infringement was $296,734.80.

JMA's motion for JMOL on the infringement verdicts was based on the argument that the CMP1 and CMP2 connectors did not have the "compression sleeve means" limitation of claim 1. The district court disagreed, stating that "evidence in support of such a finding was established through the testimony of [JMA's] expert as well as the technical literature offered by [JMA]." LRC Elecs., slip op. at 4. The district court also denied JMA's motion for JMOL on the willfulness verdict and JMA's motion for a new trial.

The district court denied LRC's motion for enhanced damages, in part because the willfulness issue "was close" and because JMA's "motivation in copying the patent was not so egregious or "permicious" as to merit an increase in damages." Id. at 6. However, the district court did award attorney fees, based in large part on the jury's willfulness verdict and the district court's understanding of the law, i.e. "where there is a finding of willfulness the Court should ordinarily award attorneys' fees or explain why it does not." Id. at 7.

On appeal, JMA challenges the district court's claim construction and contests the denial of JMOL on infringement under the doctrine as to the CMP2 connector. JMA also contests the denial of JMOL on the willfulness verdict and the finding by the district court of an "exceptional case" supporting an attorney fees award. Finally, the JMA argues that a new trial on damages is warranted because the district court excluded JMA's proffered evidence of a reasonable royalty

measure of damages as an alternative to lost profits. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1994).

## DISCUSSION

JMOL must be granted when "a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue." Thomson, S.A. v. Quixote Corp., 166 F.3d 1172, 1174, 49 USPQ2d 1530, 1531 (Fed. Cir. 1999) (quoting Johns Hopkins Univ. v. Cellpro, Inc., 152 F.3d 1342, 1353. 47 USPQ2d 1705, 1713 (Fed. Cir. 1998)). Our review of the district court's denial of JMA's motion for JMOL is de novo, reapplying the JMOL standard. See id. Under this standard of review, "we can reverse a denial of a motion for JMOL only if the jury's factual findings are not supported by substantial evidence or if the legal conclusions implied from the jury's verdict cannot in law be supported by those findings." Id.; see also Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454, 46 USPq2d 1169, 1172 (Fed. Cir.1998) (in banc).

JMA argues that the district court's decision denying JMOL with respect to the jury's finding of infringement under the doctrine of equivalents should be reversed because (1) the district court improperly instructed the jury regarding the construction of claim 1 of the '246 patent, and (2) as a matter of law the CMP2 connector could not have infringed a properly construed claim 1 under the doctrine of equivalents. Construing the means clause at issue here requires that the clause be "construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6 (1994). In its charge to the jury regarding the construction of "compression sleeve means for

snap engaging into said connector body," the district court never mentioned the written description or any structure shown therein, and never mentioned equivalents or defined application of the doctrine of equivalents to such a clause. Instead, the district court stated that "compression sleeve means is what is involved or included in performing the function of compressing the compression sleeve into the connector body in a manner that snap engages them, forming a 360-degree uniform moisture-proof seal and also preventing inadvertent disengaging." The jury instruction could have been clearer, but we need not decide whether the district court's claim construction mandates a reversal of its denial of JMOL, because we conclude that a finding of infringement under the doctrine of equivalents by the CMP2 connector of a properly construed claim 1 is legally precluded.

Looking to the written description for structure that corresponds to the means clause, here it is apparent that structure corresponding to the "snap engaging" function is a ridge on the compression sleeve and a properly-sized groove in the connector body, placed so that when the connector body is slid over the sleeve, the ridge falls into place, filling the groove. This act serves to "snap engage" the compression sleeve into the connector body, as the claim requires. The literal scope of the means clause also includes structural equivalents to the structure disclosed in the specification.

Instead of a ridge-and-groove structure, JMA's CMP2 connector utilizes an enlarged shoulder portion on the compression sleeve, which is press fit inside the connector body when the two are slid together. The jury found that the CMP2 did not literally infringe the '246 patent, but did infringe under the doctrine of equivalents.

Assuming that the doctrine of equivalents is available to LRC, [1] we hold that a finding of infringement by this device under the doctrine of equivalents cannot be sustained by law. The accused device was within the prior art. LRC "should not be able to obtain, under the doctrine of equivalents, coverage which [it] could not lawfully have obtained from the PTO [U.S. Patent and Trademark Office] by literal claims." Wilson Sporting Goods Co. v. David Geoffrey & Assocs., 904 F.2d 677, 684, 14 USPQ2d 1942, 1948 (Fed. Cir. 1990). In Wilson, we "reaffirmed the longstanding principle that the prior art restricts the scope of equivalency that the party alleging infringement under the doctrine of equivalents can assert." Conroy v. Reebok Int'l. Ltd., 14 F.3d 1570, 1576, 29 USPQ2d 1373, 1377 (Fed. Cir. 1994). To aid in this determination, it is often

> helpful to conceptualize the limitation of the scope of equivalents by visualizing a hypothetical patent claim, sufficient in scope of literally cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents.

Wilson, 904 F.2d at 684, 14 USPQ2d at 1948.

---

[1] JMA argues that the doctrine of equivalents is not available because no literal infringement was found and the structure sought to be included in the scope of equivalents under the doctrine was already known in the art and therefore was not developed after the filing of the '246 patent application, relying on chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303, 1310-11, 46 USPQ2d 1752, 1758 (Fed. Cir. 1998). Because we hold that infringement of this device under the doctrine of equivalents is precluded, we need not reach this issue.

Here, as in Wilson, a hypothetical claim that is just broad enough to include JMA's press fitting structure would not have been patentable because it would have been obvious in light of prior art coaxial connectors that utilize press fits. See also Key Mfg. Group, Inc. v. Microdot, Inc., 925 F.2d 1444, 1449, 17 USPQ2d 1806, 1810 (Fed. Cir. 1991) (finding the invention of a hypothetical claim unpatentable due to obviousness in light of prior art references). LRC stipulated that press fits have "been known to man since the 1800s" and its own witness agreed that press fits such as that used on the CMP2 connector were "known in the art" before the invention claimed in the '246 patent. Further, Core y McMills, the named inventor of U.S. Patent No. 4,583,811 ("the '811 patent") , also directed toward coaxial connectors, which is prior art to the '246 patent, testified that he used press fits "in the '811 patent." In view of the pervasiveness of press fits in the mechanical arts generally and more specifically their use in the coaxial connector industry prior to the date of invention that is claimed in the '246 patent, it would have been obvious to include such a structure at that time. Thus, a hypothetical claim including JMA's press fit limitation would not have been "allowed by the PTO over the prior art." Wilson, 904 F.2d at 684, 14 USPQ2d at 1948. Because the doctrine of equivalents cannot be applied to cover the press fit structure in JMA's CMP1 connector, the jury's infringement verdict cannot stand, and the district court's denial of JMA's motion for JMOL with respect to infringement under the doctrine of equivalents must be reversed.

In light of our reversal on the issue of infringement under the doctrine of equivalents, we vacate the district court's decision to deny JMOL as to willfulness, its denial of JMA's motion for a new damages trial, and its grant of LRC's motion

for attorney fees, [2] because each of these decisions may have been impacted by the jury's finding of infringement under the doctrine of equivalents. The case is remanded for further proceedings consistent with this opinion.

## COSTS

Each party to bear its own costs.

---

[2] We note that the district court appeared to grant LRC's motion for attorney fees because the jury found the infringement willful and the district court did not believe it had an adequate explanation of why not to grant the motion. See LRC Elecs., at 7. Although an explanation is appropriate if perhaps not absolutely required, it need not be any more than a brief statement as to why the award fees is improper, similar to a district court's explanation of its denial of enhanced damages. See Id. at 6 ("In the present case, while the Court concurs with the jury's finding of willfulness, the Court believes that the issue was close. Furthermore, the Court finds that Defendant's motivation in copying the patent was not so egregious or "pernicious' as to merit an increase in damages. While concededly, there are other factors the Court may consider which may support increasing damages, the Court finds that the circumstances of this case weigh against such an increase.").

**APPENDIX B**

**UNITED STATES COURT OF APPEALS**
**FOR THE FEDERAL CIRCUIT**

98-1545

LRC ELECTRONICS, INC.,

Plaintiff-Appellee,

v.

JOHN MEZZALINGUA ASSOCIATES, INC.,

Defendant-Appellant.

## Judgment

***ON APPEAL from the*** U.S. District Court for the Northern District of New York

***in CASE NO(S).*** 95-CV-1661

***This CAUSE having been heard and considered, it is***

***ORDERED and ADJUDGED:***

REVERSED, VACATED AND REMANDED.

**ENTERED BY ORDER OF THE COURT**

**DATED**_____

JAN HORBALY, CLERK

ISSUED AS A MANDATE: SEPTEMBER 7, 1999

## APPENDIX C

**United States Court of Appeals for the Federal Circuit**

**ORDER**

A combined petition for rehearing and suggestion for rehearing en banc having been filed by the APPELLEE, and a response thereto having been invited by the court and filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing en banc, response and the APPELLEE's reply to the response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing en banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on September 7, 1999.

FOR THE COURT
Jan Horbaly
Clerk

Dated: August 30, 1999

**FILED**
U.S. COURT OF APPEALS
THE FEDERAL CIRCUIT
AUG 30 1999

JAN HORBALY
CLERK

cc: JAMES R. MULDOON
PAUL J. HAYES

LRC V JOHN MEZZALINGUA ASSOC, 98-1545
(DCT - 95-CV-1661)

## APPENDIX D

## VERDICT FORM

**Please indicate your response on this form by placing an "X" on the appropriate line.**

### Infringement

LRC has the burden of proving infringement by a preponderance of the evidence.

...

4. Do you find that the CMP2 connector infringes claim "1" of the '246 patent under the doctrine of equivalents?

| Yes | No |
|---|---|
| X | ____ |

If you answered "yes", to the above question, please go on to the next question. If you answered "no" to the above question, answer question 1 under "Invalidity/Obviousness" and then inform the Marshall that you have reached a verdict.

...

### Invalidity/Obviousness

1. Has JMA proven by clear and convincing evidence that, in light of the prior art, the '246 patent would have been obvious to one ordinarily skilled in the art of designing coaxial cable connectors at the time the invention was made?

| Yes | No |
|---|---|
| ____ | X |

## APPENDIX E

In its Wilson Sporting Goods hypothetical claim analysis, the Panel found that the claim would be invalid as obvious in view of the '811 patent if it were construed to cover the press fit element of the CMP2 (Add.7-9). This very issue, however, was placed directly before the jury by JMA. JMA explicitly argued to the jury that the claim 1 of the '246 patent would be obvious if construed to cover the press fit structure of the CMP2 (SA4005-6). The jury rejected JMA's argument and found that the claim was not obvious. JMA did not appeal the jury's obviousness finding. Therefore, JMA is bound on that issue. Radio Steel, 731 F.2d at 844, 221 USPQ at 660. Notwithstanding the above, the Panel conducted the same obviousness analysis adversely decided by the jury and form which no appeal was taken.

LRC requests an *in banc* hearing to determine whether Wilson Sporting Goods hypothetical claim analysis is available on appeal to a defendant who put that precise issue to the jury, lost, and did not appeal therefrom. LRC submits that this is an important issue of law that should be resolved *in banc*. Otherwise, plaintiff's right to a jury and the principles of *res judicata* will be abrogated.

## APPENDIX F

And this is where we run into the problem with the claim. That if the claim is read, and remember, Mr. McMills told you he found all the other elements, if you read it broadly, in his '811 and other components in the crimp connector, the FJS LRC connector. Mr. McMills said he didn't find a snap engaging means as defined in the patent, if that means a ridge with a groove for interlocking, like a detente. So that if it comes together, it stays together until you pry it apart. But if you define compression sleeve to include press fit with no ridge, no ridge going into a groove, then this claim is invalid because press fits were around already.

That's the position as far as invalidity is concerned. You can't have it both ways. This claim, we submit, his Honor will instruct you, will be interpreted the same. There is no special rule for interpreting the claim differently for validity, I believe, than there is for infringement or you won't hear any such rule. So however you define this claim for infringement, that's how you use it in terms of his definition for validity. And if the CMP2 infringes, then we submit it's – the claim is invalid.

Supreme Court, U.S.
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No. 99-666

IN THE

# Supreme Court of the United States

LRC ELECTRONICS, INC.,

*Petitioner,*

*v.*

JOHN MEZZALINGUA ASSOCIATES, INC.,

*Respondent.*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

## RESPONDENT'S BRIEF IN OPPOSITION

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## STATEMENT PURSUANT TO RULE 29.6

Respondent, John Mezzalingua Associates, Inc., has no parent corporation and no publicly held company owns 10% or more of its stock.

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## COUNTER STATEMENT OF THE CASE

This counter-statement is necessary to correct Petitioner's misstatement of the holding of the Federal Circuit decision in this action.

This is an action for infringement of U.S. Patent No. 4,902,246 ("the '246 patent") assigned to Petitioner and entitled, "Snap-N-Seal Coaxial Connector" asserted against Respondent in the U.S. District Court for the Northern District of New York.

Early during the course of proceedings below, Respondent modified the accused product, to avoid infringement, but Petitioner maintained that both Respondent's original coaxial cable connector, called the CMP1, as well as Respondent's redesigned connector, called the CMP2, infringed claim 1 of the '246 patent. [Appendices to Petition for Writ of Certiorari (hereinafter "App.") at 3a] Respondent denied the substantive allegations of the complaint and counterclaimed for a declaration of noninfringement, invalidity and unenforceability of the '246 patent.

After a ten-day trial, the jury found that the '246 patent was not invalid or unenforceable and the CMP1 connector literally infringed claim 1. These determinations were not challenged on appeal. The jury also found that the CMP2 connector did not literally infringe claim 1; however, the jury found that the CMP2 infringed under the doctrine of equivalents. On February 9, 1998, judgment was entered in accordance with the jury verdict and an injunction issued against further infringement by Respondent. After the denial of its post-trial motions, Respondent appealed, *inter alia*, the finding of infringement under the doctrine of equivalents by the CMP2 connector.

In a non-precedential decision dated May 27, 1999, the Court of Appeals for the Federal Circuit found, after first construing claims language in a means plus function format, that Respondent had replaced the snap engaging ridge-in-groove structure required by the '246 patent with a simple "press fit." [App. at 7a] At trial, Petitioner's own expert witness acknowledged that press fits were well known in the prior art of connectors before the invention claimed in the '246 patent. [App. at 9a] Indeed, Petitioner's counsel even stipulated at trial that press fits were well known in the art. *Id.* The Federal Circuit then held that the prior art legally precluded Petitioner from asserting infringement under the doctrine of equivalents. *Id.*

In reaching this result the Federal Circuit simply applied this stipulated fact to the well-recognized, often-employed methodology called "hypothetical claim analysis," first delineated in the seminal case of *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684, 14 U.S.P.Q. 2d 1942, 1948 (Fed. Cir.), *cert. denied*, 498 U.S. 992, 111 S. Ct. 537, 112 L. Ed. 2d 547 (1990). [App. at 8a-9a] The Federal Circuit thus found that a "hypothetical claim" that was drafted broadly enough to ensnare the accused structure would not be patentable over the prior art. [App. at 9a] Contrary to Petitioners representations, it was the hypothetical claim and not the actual patent claim that the Federal Circuit analyzed and held to be unpatentable and, therefore, the validity of the actual patent claim was never at issue. Consequently, the Federal Circuit reversed the jury's finding of infringement under the doctrine of equivalents by the CMP2 *as a matter of law.*

## REASONS FOR DENYING THE WRIT

### I.

### THE LIMITING EFFECT OF PRIOR ART ON THE APPLICATION OF THE DOCTRINE OF EQUIVALENTS IS A QUESTION OF LAW

This Court recently reaffirmed the viability of infringement under the doctrine of equivalents in *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L. Ed. 2d 146 (1997). However, there are two well-recognized principles which may preclude a patent owner from the application of the doctrine of equivalents. First, the doctrine cannot be used to recapture subject matter that was relinquished by distinguishing the claimed invention over the prior art during prosecution of the patent. 520 U.S. at 31, 117 S. Ct. at 1049-50. This principle is commonly referred to as prosecution history estoppel and was squarely addressed in *Warner-Jenkinson*. The second limiting principle is that the doctrine of equivalents cannot be used to protect subject matter in, or obvious in light of, the prior art. *Athletic Alternatives Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1583, 37 U.S.P.Q. 2d 1365, 1373 (Fed. Cir. 1996); *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 684, 14 U.S.P.Q. 2d 1942, 1948 (Fed. Cir.), *cert. denied*, 498 U.S. 992, 111 S. Ct. 537, 112 L. Ed. 2d 547 (1990); *Pennwalt Corp. v. Durand-Wayland*, Inc., 833 F.2d 931, 934, 4 U.S.P.Q. 2d 1737, 1739 (Fed. Cir. 1987) (*en banc*), *cert. denied*, 485 U.S. 961, 108 S. Ct. 1226, 99 L. Ed. 2d 426, 485 U.S. 1009, 108 S. Ct. 1474, 99 L. Ed. 2d 703 (1988). Whether an asserted range of equivalence would encompass what is already in the prior art has always been determined to be a question of law. *Id.*

Indeed, in *Warner-Jenkinson*, this Court acknowledged that these legal limitations on the application of the doctrine of equivalents are issues that a court can determine as a matter of law:

> Of course, the various legal limitations on the application of the doctrine of equivalents are to be ***determined by the court***, either on a pretrial motion for partial summary judgment or on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict.

*Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39 n.8, 117 S. Ct. 1040, 1053 n.8, 137 L. Ed. 2d 146 (1997), citing Fed. Rule Civ. Proc. 56; Fed. Rule Civ. Proc. 50 (*emphasis added*). Moreover, it is established law that there is no right to a jury trial where there are no issues of material fact to be tried by the jury, so that a proper summary judgment or judgment as a matter of law does not violate the Seventh Amendment. E.g., *Ex parte Peterson*, 253 U.S. 300, 310-11, 40 S. Ct. 543, 546-47, 64 L. Ed. 919 (1920); *Neely v. Martin K. Eby Construction Co., Inc.*, 386 U.S. 317, 322, 87 S. Ct. 1072, 1076, 18 L. Ed. 2d 75 (1967). Thus, under long-standing Federal Circuit and Supreme Court precedent, the Federal Circuit's finding that Petitioner was precluded as a matter of law from asserting the doctrine of equivalents because of the prior art in this action did not deprive Petitioner of its constitutional right to a jury trial.

## II.

## PETITIONER MISSTATES THE LAW REGARDING WILSON SPORTING GOODS' HYPOTHETICAL CLAIM ANALYSIS

The Petition should also be denied because it is grounded on a misstatement of the law regarding the fundamental distinction between the validity of the claims under 35 U.S.C. § 103 and the limiting effect of prior art on the application of the doctrine of equivalents under the hypothetical claim analysis of *Wilson Sporting Goods*. The difference between these issues was discussed at length by the Federal Circuit in *Wilson Sporting Goods* and exposes the fallacy of Petitioner's reasoning. 904 F.2d at 685, 14 U.S.P.Q. 2d at 1949.

Under 35 U.S.C. § 103, a patent may not be obtained where the differences between an invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art" to which the invention pertains. *Id.* The claims of an issued patent have a strong presumption of validity in infringement proceedings, 35 U.S.C. § 282, and a party challenging validity of a claim must prove by clear and convincing evidence that prior art references would have rendered the invention obvious to one of ordinary skill in the art at the time of invention. *Al-Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1323, 50 U.S.P.Q. 2d 1161, 1170 (Fed. Cir. 1999). Thus, an extremely high burden attends any effort to invalidate a patent.

In contrast, the question of infringement presents different issues and a different burden of proof, which as in *Wilson Sporting Goods*, did not require a court to review the jury finding of validity of the asserted claim. 904 F.2d at 686, 14 U.S.P.Q. 2d at 1950. Rather, the issue regarding infringement was whether the prior art restricted the patentee from asserting the doctrine of equivalents. 904 F.2d at 684-85, 14 U.S.P.Q. 2d at 1947-48. In resolving this issue, the Federal Circuit delineated its "hypothetical claim analysis." The Court explained:

> Whether prior art restricts the range of equivalents of what is literally claimed can be a difficult question to answer. To simplify analysis and bring the issue onto familiar turf, it may be helpful to conceptualize the limitation on the scope of equivalents by visualizing a ***hypothetical*** patent claim, sufficient in scope to ***literally*** cover the accused product. The pertinent question then becomes whether that hypothetical claim could have been allowed by the PTO over the prior art. If not, then it would be improper to permit the patentee to obtain that coverage in an infringement suit under the doctrine of equivalents. If the hypothetical claim could have been allowed, then ***prior art*** is not a bar to infringement under the doctrine of equivalents.

*Wilson Sporting Goods*, 904 F.2d at 684, 14 U.S.P.Q. 2d at 1948 (*emphasis in original*). Moreover, the burden of proof is drastically different in determining whether the prior art precludes the application of the doctrine of equivalence. As the Federal Circuit noted:

> [T]he burden is on Wilson [the patent owner] to prove that the range of equivalence which it seeks would not ensnare the prior art . . . Leaving this burden on Wilson does not, of course, in any way undermine the presumed validity of Wilson's actual patent claims. In the present situation, Wilson's ***claims will remain valid*** whether or not Wilson persuades us that it is entitled to the range of equivalence sought here.

904 F.2d at 685, 14 U.S.P.Q. 2d at 1949 (*emphasis added*).

Of course, the Federal Circuit has made it clear that this hypothetical claim analysis of *Wilson Sporting Goods* merely is an optional, and not required, methodology for determining the limiting effects of prior art on the application of the doctrine of equivalents. *International Visual Corp. v. Crown Metal Manufacturing Co., Inc.*, 991 F.2d 768, 772, 26 U.S.P.Q. 2d 1588, 1591 (Fed. Cir. 1993). Thus, it is irrelevant whether the Federal Circuit relied upon the optional hypothetical claim analysis, or some other framework for determining the well-settled point of law that the doctrine of equivalents cannot be used to protect subject matter in, or obvious in light of, the prior art. The outcome would have remained the same. *See, e.g., Senmed, Inc. v. Richard-Allan Med. Industrial,* 888 F.2d 815, 821, 12 U.S.P.Q. 2d 1508, 1513 (Fed. Cir. 1989); *Stewart-Warner Corp. v. City of Pontiac, Mich.*, 767 F.2d 1563, 1572, 226 U.S.P.Q. 676, 682 (Fed. Cir. 1985); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1310-11, 46 U.S.P.Q. 2d 1752, 1758 (Fed. Cir. 1998).

As the doctrine of equivalents relates solely to the issue of infringement, the Court's ruling that Petitioner was

precluded from asserting the doctrine of equivalents did not and could not affect the jury's finding of validity of the actual patent claim. The analysis and burdens of proof on validity and infringement are distinct and separate issues. As recognized by this Court in a long line of Federal Circuit precedent, the limitation on the doctrine of equivalents by the prior art is a question of law regardless of the methodology used and, therefore, the Federal Circuit decision reversing the finding of infringement by the CMP2 was appropriate. For this additional reason, Petitioner has not been denied its constitutional right to a jury trial.

## CONCLUSION

Petitioner stipulated that the press fit structure of the CMP2 was in the prior art. The Federal Circuit merely applied well-established law in finding as a matter of law that the CMP2 did not infringe the asserted claim under the doctrine of equivalents. The Federal Circuit's decision is not in conflict with the Constitution or any other court decision.

For the reasons stated above, it is respectfully submitted that the Petition for Writ of Certiorari in this matter should be denied.

Respectfully submitted,

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